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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/835,325	04/17/2001	Sue-Ken Yap	169.2024	5352

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EXAMINER

NOWLIN, APRIL A

ART UNIT

PAPER NUMBER

2876

DATE MAILED: 05/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/835,325

Applicant(s)

YAP ET AL.

Examiner

April A. Nowlin

Art Unit

2876

-- Th MAILING DATE of this communication appears on the cover sheet with the corresponding address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-82 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 68-73, 75, 77, 79 and 80 is/are allowed.
- 6) ☒ Claim(s) 1-9, 12-20, 23, 26, 29-35, 37-39, 42-50, 53, 56, 61-67, 74, 76 and 78 is/are rejected.
- 7) ☒ Claim(s) 10, 11, 21, 22, 24, 25, 27, 28, 36, 40, 41, 51, 52, 54, 55, 57-60, 81 and 82 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 10. 6) ☐ Other:

DETAILED ACTION

Preliminary Amendment

1. Receipt is acknowledged of the Preliminary Amendment filed 31 May 2001.

Priority

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Specification

3. The abstract of the disclosure is objected to because the term "Fig. 10A and 10B" should be deleted. Correction is required. See MPEP § 608.01(b).
4. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Objections

5. Claims 2-30, 32-60, 63, 64, 69-73, 75, 76, 78, 81, and 82 are objected to because of the following informalities:

Re claims 2-30, 32-60, 63, and 69-73: Substitute "A" with -- The -- (see line 1).

Re claim 22: Delete "comprises" (see line 2).

Re claim 52: Delete "comprises (see line 2)

Re claims 64, 75, and 76: Substitute "Apparatus" with -- An apparatus -- (see line 1).

Re claim 76: Substitute "form" with -- from -- (see line 5).

Re claim 78: Substitute "form" with -- from -- (see line 5)

Re claim 81: Substitute "form" with -- from -- (see line 5, page 2 of paper no. 4).

Re claim 82: Substitute "firs" with -- first -- (see line 5, page 3 of paper no. 4) and "si" with -- is-- (see line 9 of paper no. 4).

Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 5, 8, 17, 18, 26, 29, 30, 38, 47, 48, and 56 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5 recites the limitation "the controlling program" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 8 recites the limitation "the controlling program" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 8 recites the limitation "the first mode" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 17 recites the limitation "the controlling program" in line 4. There is insufficient antecedent basis for this limitation in the claim.

Claim 17 recites the limitation "said processing device" in line 5. There is insufficient antecedent basis for this limitation in the claim.

Claim 17 recites the limitation "the first mode" in line 5. There is insufficient antecedent basis for this limitation in the claim.

Claim 18 recites the limitation "the controlling program" in line 4. There is insufficient antecedent basis for this limitation in the claim.

Claim 18 recites the limitation "said processing device" in line 5. There is insufficient antecedent basis for this limitation in the claim.

Claim 18 recites the limitation "the first mode" in line 5. There is insufficient antecedent basis for this limitation in the claim.

Claim 26 recites the limitation "the browsing of content" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 26 recites the limitation "the purchase" in lines 2 and 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 29 recites the limitation "the processing device" in line 6. There is insufficient antecedent basis for this limitation in the claim.

Claim 38 recites the limitation "the first mode" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 47 recites the limitation "the first mode" in line 4. There is insufficient antecedent basis for this limitation in the claim.

Claim 48 recites the limitation "the first mode" in line 4. There is insufficient antecedent basis for this limitation in the claim.

Claim 56 recites the limitation "the browsing of content" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim 56 recites the limitation "the purchase" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-7, 9, 12-16, 19, 20, 23, 31-35, 37, 39, 42-46, 49, 50, 53, 61-67, 74, 76, and 78 are rejected under 35 U.S.C. 102(b) as being anticipated by Arnold (US 5,526,428).

Re claim 1, 31, 61, 62, 64-67, 74, 76, and 78: Arnold discloses an access control apparatus and method comprising: initiating a session of an application when a first smart card 21 associated with the application is inserted into a reader 31; maintaining the session active when the first smart card 21 is removed from the reader 31 and a second smart card 11 associated with the first smart card 21 is to be inserted in the reader 31; and performing an action when a second smart card 11 is inserted in the reader 31. (See col. 5, lines 1-59; and col. 6, line 1 to col. 8, line 32)

Re claims 2 and 32: wherein the initiating of the session comprises loading and executing the application (see col. 5, lines 1-59).

Re claims 3 and 33: wherein the initiating of the session comprises starting of an instance of the application, which is already running (see col. 5, lines 1-59).

Re claims 4, 9, 34, and 39: wherein the performing step comprises transmitting, upon insertion of the second smart card 11 into the reader 31, data read from the second smart card 11 to the application (see col. 5, lines 1-59).

Re claims 5 and 35: wherein the maintaining step comprises transmitting a message from the application to a controlling program indicating that a second smart card 11 is required to be inserted in the reader 31; and waiting for the insertion of the second smart card 11 in the smart card reader 31 (see col. 5, lines 1-59).

Re claim 6: wherein the maintaining step comprises the sub-step of terminating the session after a predetermined time if the second smart card has not been inserted in the reader.

Re claims 7, 37, and 63: wherein the performing the step comprises receiving a message from the smart card reader 31 that a smart card has been inserted; determining whether the inserted smart card is a second smart card 11; and transmitting, upon determination that the inserted smart card is the second smart card 11, data read from the second smart card to the application (see col. 5, lines 1-59).

Re claims 12 and 42: wherein each smart card has an identifier uniquely identifying the application.

Re claims 13 and 43: wherein each smart card has an identifier uniquely identifying the application and the determining step determines the inserted smart card by the unique identifier.

Re claims 14 and 44, wherein the data is an address to a computer program.

Re claims 15 and 45: wherein the method comprises the step of executing the computer program.

Re claims 16 and 46: wherein the data is for information purposes of the application.

Re claims 19 and 49: wherein the initiating step comprises reading an address of the application from the first smart card 21; and loading and executing the application using the address (see col. 5, lines 1-59).

Re claims 20 and 50: wherein the second smart card 11 comprises personal information data of a user and the performing step comprises transferring the data to the application (see col. 5, lines 1-59).

Re claims 23 and 53: wherein the second smart card 11 comprises business information data of a user and the performing step comprises transferring the data to the application (see col. 5, lines 1-59).

Allowable Subject Matter

10. Claims 68-73, 75, 77, 79, and 80-82 are allowable over prior art.

The following is a statement of reasons for the indication of allowable subject matter: The prior art of record, taken alone or in combination, fail to teach or fairly

suggest a method of using multiple smart cards, aggregated into a lesser plurality of groups of smart cards, the method comprising the steps of:

reading and storing, if the first smart card is a base smart card, (i) an identity for a group, (ii) an identity of the base smart card, (iii) an interface description for the base smart card, (iv) an identity for at least one associated member card, and (v) an interface description for the at least one associated member card;

ejecting the first smart card from the smart card reader and inserting a second smart card therein, the smart card reader making accessible a user selectable icon, having an associated action, on a surface of the inserted second smart card;

reading, if the second inserted smart card is a member card associated with the base smart card, of (i) the identity of the group, to which the second inserted smart card is associated, and (ii) an identity of the inserted associated member smart card; and

comparing the group identity read from the first smart card to the group identity read from the second smart card; and enabling, because the compared group identities match, the associated action if a user selects the user selectable icon, whereby the association between the icon and the action is defined by the interface description for the associated member smart card read and stored from the associated base smart card.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Pat. No. 6,477,511 to Guenther

US Pat. No. 6,418,422 to Guenther et al

US Pat. No. 6,405,369 to Tsuria

US Pat. No. 6,298,441 to Handelman et al

US Pat. No. 6,199,752 to Bornemann et al

12 Any inquiry concerning this communication or earlier communications from the examiner should be directed to April A. Nowlin whose telephone number is (703) 605-1219. The examiner can normally be reached on Monday - Friday from 6:30AM - 4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (703) 305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7382 for After Final communications.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [april.nowlin@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



AAN
May 19, 2003



**THIEN M. LE
PRIMARY EXAMINER**